

DEC 21 2007

PATENT

APPLICATION 10/064,251

ATTORNEY DOCKET 2001-0337 (1014-284)

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Claim 17 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 6, 10 is in independent form.

I. The Obviousness Rejections

Each of claims 1-20 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent Publication 20010032271 ("Allen"), U.S. Patent 5,856,981 ("Voelker"), U.S. Patent 6,366,761 ("Montpetit"), U.S. Patent 6,741,572 ("Graves"), U.S. Patent 6,442,132 ("Burns"), U.S. Patent Publication 20010036153 ("Sasaki"), U.S. Patent 7,099,327 ("Nagarajan"), U.S. Patent 7,039,687 ("Jamieson"), and/or U.S. Patent Generalized MPLS - Signaling Functional Description, draft - Network Working Group Internet Draft, May 2001 ("Berger"). Each of these rejections is respectfully traversed.

A. Legal Standards

1. *Prima Facie* Criteria for an Obviousness Rejection

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

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1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*'s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). In *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007), the United States Supreme Court clarified that:

1. "[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art";
2. "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art";
3. it is necessary "to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit"; and
4. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

To establish a *prima facie* case of obviousness, certain criteria must be met. Evidence must be provided that indicates that the combination was obvious to a person with ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). That evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). There must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. In addition, the prior art reference (or references when combined) must

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teach... all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered'". MPEP 2143.03, *quoting In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see also, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

3. Official Notice

Regarding Official Notice, MPEP § 2144.03.A states (emphasis added):

[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of **instant and unquestionable demonstration as being well-known**. For example, assertions of... specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in

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the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. *See also In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).

Further, if an applicant traverses the examiner's assertion of Official Notice, the examiner **must provide documentary evidence** in the next Office Action if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2) and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) ("[T]he Board cannot simply reach conclusions based on its own understanding or experience, or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.").

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

Thus, to the extent that Official Notice is explicitly or implicitly utilized to support any rejection, such as the rejection of any of claims 1-20, each such rejection is respectfully traversed and citation and provision of a reference that supports the rejection is respectfully requested.

4. Unfounded Assertions of Knowledge

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

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5. "Critical" Claim Limitations

Claims are not legally required to include "critical" limitations. *See, W.L. Gore & Assocs. V. Garlock, Inc.*, 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

A contention that allegedly "uncritical" limitations in a claim can not form the basis for patentability also is legally unsound. The inference of such a general or *per se* rule of obviousness from cases turning on specific facts has no basis in law. Further, the application of such a *per se* rule to reject a claim constitutes additional legal error because it bypasses the particularized fact-specific inquiry required by § 103(a). *See, In re Ochiai*, 71 F. 3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1995); *In re Wright*, 343 F.2d 761, 767-770, 145 USPQ 190 (CCPA 1965).

6. Pertinent Prior Art References

The *Graham* analysis requires that, to rely on a prior art reference as a basis for a rejection, the USPTO must show that the reference is "reasonably pertinent to the particular problem with which the invention was involved." *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664, 57 USPQ2d 1161, 1166 (Fed. Cir. 2000); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992); *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006).

"References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) ("[I]t is necessary to consider 'the reality of the circumstances,'—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor" (*quoting In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

"If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less

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motivation or occasion to consider it.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (citing *In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992)).

Yet “[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (quoting *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000)).

7. Lack of Evidence of Reasons for Combining References

Under the *Graham* analysis, the “examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP 2142. The requirements for meeting this burden are clear.

To factually support a *prima facie* conclusion of obviousness, an Office Action must provide evidence that indicates that the combination was obvious to a person with ordinary skill in the art. The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007) (quoting *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006).

8. The Applied Reference(s) Must Be Enabling

“In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method.” *Rockwell Int’l Corp. v. U.S.*, 147 F.2d 1358, 47 USPQ2d 1027 (Fed. Cir. 1998); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1471, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997); *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989); *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006).

9. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based

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on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

B. Analysis

1. Claims 1-5 and 16-20

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 1, from which each of claims 2-5 and 16-20 ultimately depends, states, *inter alia*, yet no substantial evidence is of record that the applied portions of the relied-upon references teach, “responsive to a determination that the label switched path has been normalized back to the service path, sending a release request to a plurality of nodes along the restoration path, the release request adapted to cause a release of a restoration path resource allocation, the label switched path normalized responsive to a repair of a failure of at least one component comprised by the service path, **the release request comprising a shared reservation flag adapted to cause the release of the restoration path resource allocation without causing a release of reserved resources associated with the restoration path and without causing a removal of the restoration path**”.

The present Office Action appears to impermissibly not consider all words of claim 1 by stating, at Page 5:

Montpetit discloses a message with a flag wherein the flag is used to indicate resources should either be allocated or de-allocated. **(He teaches a bandwidth**

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**request message with a flag set to either cause allocating or de-allocating of
bandwidth - see Column 10:50-62 and Figure 8)**

Yet Figure 8A of Montpetit (Applicant assumes that the present Office Action intended to refer to Figure 8A since Montpetit has no "Figure 8" and the discussion of col. 10, lines 50-62 pertains to Figure 8A) merely illustrates:

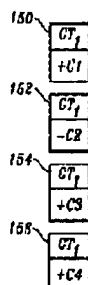


Fig. 8A.

Montpetit states at col. 10, lines 50-62:

FIG. 8A illustrates a first bandwidth allocation 50 request 150 identifying ground terminal 'GT₁' as requesting an amount C1 of uplink bandwidth for P1 status data packets. Similarly, bandwidth allocation requests 154 and 156 identify GT₁ as requesting the amounts C3 and C4 of uplink bandwidth for P3 and P4 status data packets, respectively. A sign bit included in the bandwidth request indicates whether the request is for allocation of bandwidth (e.g., using a plus sign or a positive number) or deallocation of bandwidth (e.g., using a minus sign or negative number). Bandwidth request 152 therefore indicates a request to deallocate uplink bandwidth in the amount C2 for P2 status data packets.

The present Office Action presents no evidence that these applied portions of Montpetit, or any other applied portion of any relied upon reference, teach or enable any "flag" that is "adapted to cause the release of the restoration path resource allocation **without causing a release of reserved resources associated with the restoration path and without causing a removal of the restoration path**". Thus, the present Office Action fails to provide substantial evidence that the applied portions of the relied-upon references, either alone or in combination, teach or enable, "the release request comprising a shared reservation flag adapted to cause the

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release of the restoration path resource allocation without causing a release of reserved resources associated with the restoration path and without causing a removal of the restoration path”.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Montpetit is Non-Analogous Art to the Claimed Subject Matter

Montpetit is directed towards (emphasis added) “[a] data communication system and method that allocates an amount of bandwidth to a ground terminal for uplink transmission of one or more data packets in **a low-Earth-orbit (LEO) satellite data communication network**.”
See Abstract.

Thus, Montpetit relates to allocating bandwidth “**in a low-Earth-orbit (LEO) satellite data communication network**”.

By contrast, claim 1 is directed toward a “method for signaling in a mesh telecommunication network” that relates to “label switched path[s]”.

No evidence of record indicates that allocating bandwidth “**in a low-Earth-orbit (LEO) satellite data communication network**” is in the same field of endeavor as a “method for signaling in a mesh telecommunication network” that relates to “label switched path[s]”.

Likewise, no evidence of record is presented that allocating bandwidth “**in a low-Earth-orbit (LEO) satellite data communication network**” would have been “reasonably pertinent to the particular problem with which the inventor was involved” regarding a “method for signaling in a mesh telecommunication network” that relates to “label switched path[s]”.

For at least these reasons a withdrawal of Montpetit as a reference used as a basis for rejecting any of the claims of the present application is respectfully requested.

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d. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103. For at least these reasons, Applicant respectfully requests a reconsideration and withdrawal of each rejection of each of claims 1-5 and 16-20.

e. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide sufficient evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Montpetit with applied portions of Allen and Voelker, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 1, in such a manner so as to arrive at the claimed subject matter of claim 1. Regarding the proffered combination of Montpetit with Allen and Voelker, the present Office Action states, at Page 5:

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allen's method to include a step of using a message with a flag wherein the flag is used to indicate resources should either be allocated or deallocated. The motivation being to establish in existing data communication networks a mechanism whereby bandwidth is allocated on-demand.

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*.

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Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

f. Conclusion

For at least this reason, it is respectfully submitted that the rejection of claim 1 is unsupported by the applied portions of the relied-upon references and should be withdrawn. Also, the rejection of claims each of claims 2-5 and 16-20, each of which ultimately depends from claim 1, is unsupported by the applied portions of the relied-upon references and also should be withdrawn.

2. Claim 6

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 6 states, *inter alia*, yet no substantial evidence is of record that the applied portions of the relied-upon references teach, "the second message comprising an object that comprises a code, a first possible value of the code indicative that bridging has been completed, a second possible value of the code indicative that a roll/bridge has been completed, a third possible value of the code indicative that a roll has been completed".

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in modifying the applied portions of reference relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the reference relied upon in the Office Action, **as attempted to be modified**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

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c. The Unfounded Assertions Fail to Bridge the Missing Claim Limitations

Regarding this claimed subject matter, which the present Office Action admits is not taught by the applied portions of the relied-upon references, the present Office Action states, at Pages 8-9:

Burns does not expressively disclose that the second message comprises an object that comprises a code, a first possible value of the code indicative that bridging has been completed, a second possible value of the code indicative that a roll/bridge has been completed, a third possible value of the code indicative that a roll has been completed. However, Burns clearly shows message exchanges occur between the source and destination in attempting to set up a bridge and roll operation, which is a notoriously known telecom operation. Clearly Burns teaches the second message in Column 4:10 indicating a roll completion and as suggested by Burns in Column 3:55 a bridge has to occur at the destination before the destination rolls and hence the same message can be interpreted to be a bridge and roll completion too. Hence it is the position of the Examiner that the teachings of Burns suggest a 2nd message indicating the completion of roll and roll/bridge operation at the destination. Even though the Applicant claims a 2nd message with a data structure of an object code or flag with different values, the claimed 2nd message simply accomplishes the well known bridge and roll operation. The Applicant's 2nd message is simply a different way of accomplishing the well known bridge and roll operation that is adequately taught by Burns and the Applicant has not established any criticality for the need of such a 2nd message with such an obvious type of flag or code. Therefore it will be obvious to one ordinarily skilled in the art to either use Burn's or Applicant's or any variation of Burn's method to accomplish the same end result, the end result being a bridge and roll operation.

The reliance by the Office Action on an unfounded assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap posed by the applied

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portions of the relied-upon references is improper. Such unfounded assertions are not permissible substitutes for evidence.

Moreover, the present Office Action's criticism of the claim limitations at issue as not being critical is of no moment. The contention that uncritical limitations pertaining to differences in a claim can not form the basis for patentability also is unsound. The inference of such a general or *per se* rule of obviousness from cases turning on specific facts has no basis in law. In addition, applicant also respectfully traverses the apparent denigration of the claimed subject matter by the unsupported assertion that the claimed subject matter comprises "such an obvious type of flag or code".

d. Lack of Enablement of the Claimed Subject Matter

The present Office Action presents no evidence that the applied portions of the relied-upon references would enable one having ordinary skill in the art to practice the claimed subject matter of "the second message comprising an object that comprises a code, a first possible value of the code indicative that bridging has been completed, a second possible value of the code indicative that a roll/bridge has been completed, a third possible value of the code indicative that a roll has been completed".

e. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103. For at least these reasons, Applicant respectfully requests a reconsideration and withdrawal of the rejection of claim 6.

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f. Conclusion

Because no *prima facie* rejection has been presented, Applicant respectfully requests a reconsideration and withdrawal of the rejection of claim 6. Applicant also requests a reconsideration and withdrawal of each rejection of each of claims 6-9, each of which ultimately depends from claim 6.

3. Claim 10

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 10 states, *inter alia*, yet no substantial evidence is of record that the applied portions of the relied-upon references teach, “the second message comprising an object that comprises a code, **the code indicative that bridging, has been completed, that a roll/bridge has been completed, or that a roll has been completed**”.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in modifying the applied portions of reference relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the reference relied upon in the Office Action, as attempted to be modified, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. The Unfounded Assertions Fail to Bridge the Missing Claim Limitations

Regarding the admittedly missing claimed subject matter of claim 6 of “the second message comprising an object that comprises a code, a first possible value of the code indicative that bridging has been completed, a second possible value of the code indicative that a roll/bridge

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has been completed, a third possible value of the code indicative that a roll has been completed", the present Office Action asserts, at Pages 10-11

Burns does not expressively disclose that the second message comprises an object that comprises a code, a first possible value of the code indicative that bridging has been completed, a second possible value of the code indicative that a roll/bridge has been completed, a third possible value of the code indicative that a roll has been completed. However, Burns clearly shows message exchanges occur between the source and destination in attempting to set up a bridge and roll operation, which is a notoriously known telecom operation. Clearly Burns teaches the second message in Column 4:10 indicating a roll completion and as suggested by Burns in Column 3:55 a bridge has to occur at the destination before the destination rolls and hence the same message can be interpreted to be a bridge and roll completion too. Hence it is the position of the Examiner that the teachings of Burns suggest a 2nd message indicating the completion of roll and roll/bridge operation at the destination. Even though the Applicant claims a 2nd message with a data structure of an object code or flag with different values, the claimed 2nd message simply accomplishes the well known bridge and roll operation and cannot be given any patentable weight. The Applicant's 2nd message is simply a different way of accomplishing the well known bridge and roll operation that is adequately taught by Burns and the Applicant has not established any criticality for the need of such a 2nd message with such an obvious type of flag or code.

As an initial matter, Applicant respectfully traverses this assertion as without any evidentiary basis. In addition, the reliance by the Office Action on such an unfounded assertion to bridge the evidentiary gap posed by the applied portions of the relied-upon references is improper. Such unfounded assertions are not permissible substitutes for evidence.

Moreover, the present Office Action's criticism of the claim limitations at issue as not being critical is of no moment. The contention that uncritical limitations pertaining to differences in a claim can not form the basis for patentability also is unsound. The inference of such a general or *per se* rule of obviousness from cases turning on specific facts has no basis in

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law. In addition, applicant also respectfully traverses the apparent denigration of the claimed subject matter by the unsupported assertion that the claimed subject matter comprises "such an obvious type of flag or code".

d. Lack of Enablement of the Claimed Subject Matter

The present Office Action presents no evidence that the applied portions of the relied-upon references would enable one having ordinary skill in the art to practice the claimed subject matter of "the second message comprising an object that comprises a code, the code indicative that bridging, has been completed, that a roll/bridge has been completed, or that a roll has been completed".

e. Inadequate Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art and identify the scope and contents to Applicant as required under *Graham*. The present Office Action also fails to even identify what "the pertinent art" is and notably fails to resolve the level of ordinary skill in the pertinent art. In addition, no evidence is presented that the present Office Action has considered objective evidence indicating obviousness or nonobviousness.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and respectfully requests a withdrawal of the rejection of claim 10 or a non-final Office Action that complies therewith.

f. Conclusion

Because no *prima facie* rejection has been presented, Applicant respectfully requests a reconsideration and withdrawal of the rejection of claim 10. Applicant also requests a reconsideration and withdrawal of each rejection of each of claims 11-15, each of which ultimately depends from claim 10.

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4. Claim 17

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

Claim 17 states, *inter alia*, yet no substantial evidence is of record that the applied portions of the relied-upon references teach, “reserving the resources along the restoration path if and only if the label switched path request comprises a shared reservation flag, the shared reservation flag indicative of whether other flags are needed to support restoration”.

Regarding this claimed subject matter the present office action asserts, at Page 6, “Montpetit teaches a bandwidth request message with a flag set to either cause allocating or de-allocating of bandwidth - see Column 10:50-62 and Figure 8”. Yet these applied portions of Montpetit are presented regarding the traversal of the rejection of claim 1. Applicant respectfully submits that the present Office Action presents no evidence that the applied portions of Montpetit teach or enable:

1. any action regarding any “label switched path request” whatsoever;
2. any flag that is “indicative of whether other flags are needed to support restoration” whatsoever; and/or
3. “reserving the resources along the restoration path if and only if the label switched path request comprises a shared reservation flag, the shared reservation flag indicative of whether other flags are needed to support restoration”.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in modifying the applied portions of reference relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the reference relied upon in the Office Action, **as attempted to be modified**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Because no *prima facie* rejection has been presented, Applicant respectfully requests a reconsideration and withdrawal of the rejection of claim 10. Applicant also requests a

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reconsideration and withdrawal of each rejection of each of claims 11-15, each of which ultimately depends from claim 10.

II. Next Office Action

Because the present Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied references will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

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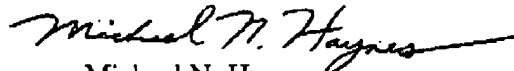
CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



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